

REMARKS

Claims 1, 2, 6-11, 14-16, 19-21, and 25-34 are pending in the present application. Claims 1, 11, 16, 20, 30, 33, 35 and 42 are independent. Claims 35-44 have been added to more particularly define what the Applicants regard as the invention.

35 USC 103 Blatter-Ohishi Rejection

Claims 1, 2, 6, 8-11, 16, 17, 20, 21, 25, 27-30, and 33 are rejected under 35 USC 103(a) as being unpatentable over Blatter (USP 6,016,348) in view of Ohishi (USP 5,909,257). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

The May 23, 2005 Office Action contains a Response to Arguments section that is quite instructive both in terms of the Office Action's insufficiency and in terms of Applicants' efforts to advance prosecution despite the Office Action's insufficiencies.

First of all, the Office Action responds to one of Applicants' arguments, namely that there is no disclosure or suggestion in any of the applied art of an information table generator that substitutes a specific value for a PID value to generate a PMT and that instead, Ohishi generates PSSIs not new PMTs. In response to this argument, the Office Action states in part "the specific types of tables Ohishi generates are irrelevant to the relied upon teachings of Ohishi and the corresponding motivations."

Applicants find it simply incredible that this argument was even made. The specific types of tables Ohishi generates are indeed relevant, particularly because many of the above claim amendments more specifically identify the various tables utilized and processed by the invention. The Office Action appears to ignore the fact that Blatter and Ohishi are directed to different purposes and that combining them, as the Office Action

suggests, is truly an exercise in hindsight reconstruction. Indeed, the Examiner's argument that Ohishi's tables are irrelevant clearly shows that the Examiner is haphazardly combining references without proper motivation and must be utilizing the specification as a guide to combine the disparate teachings of Ohishi and Blatter.

Obviousness cannot be established by hindsight combination to produce the claimed invention. *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). It is the prior art itself, and not the appellants' achievement, that must establish the obviousness of the combination. Therefore, Appellants submit that the only motivation to make such modifications to Blatter and Ohishi is based on an impermissible hindsight reference to Appellants' specification.

Appellant respectfully submits that an analysis of the propriety of any rejection under 35 U.S.C. § 103(a) begins with the text of that section, particularly the phrase "at the time that the invention was made." It is this phrase which guards against entry into the "tempting but forbidden zone of hindsight." *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1616 (Fed. Cir. 1999). Measuring a claimed invention against the standard established by Section 103 "requires the often difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then accepted wisdom in the field." *Id.*, 50 U.S.P.Q.2d at 1617.

The Federal Circuit has made it very clear that "the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. Combining prior art references without evidence of such a suggestion,

teaching, or motivation simply takes the inventor's disclosures as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.” *Id.*

The required “evidence” of a teaching, suggestion or motivation to make the cited combination of references can be found in the prior art references themselves (the most typical location), the knowledge of one of ordinary skill in the art, or in some cases, from the nature of the problem to be solved. *Id.* The range of potential sources; however, does nothing to diminish the requirement for actual evidence. “The showing must be clear and particular” and cannot be met by broad conclusory statements. *Id.*

There is simply no evidence of record in this application that provides any teaching, suggestion or motivation to so modify the cited prior art reference, let alone a showing that is “clear and particular” as it must be. *See, e.g., In re Dembiczak, supra*, 50 U.S.P.Q.2d at 1617. Hence, to the limited extent that the cited reference might be modified so as to accomplish Appellant's claimed invention (a fact that Appellant strongly contends, *supra*, cannot be done), it is only through the “blueprint drawn by the inventor,” *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 547 (Fed. Cir. 1985), that that combination can be assembled, not from the state of the art at the time of Appellant's invention as it must be.

Applicants again assert that there is no motivation for combining Ohishi with Blatter as the Office Action suggests other than the improper utilization of hindsight reconstruction.

In a more positive light, Applicants recognize that perhaps one of the previous arguments raised was not explicitly recited in the claims. As pointed out in section 5aib (page 22) of the Office Action, Applicants had argued that retaining the “specific value”

(that is substituted for the PID value of a packet for transmitting an ES described in the PMT) permits the reproduction unit to reproduce the transmitted package stream without verifying contents of the PAT or PMT. In other words, because this feature was not recited in the claims, it was not given patentable weight by the Examiner.

In response, Applicants have amended the relevant claims to recite a similar feature and thereby further distinguish over the applied art. This feature will be argued in detail below.

The present Office Action and previous Office Action clearly admitted that the primary reference (Blatter) fails to disclose an information table generator which substitutes a specific value for the PID value of a packet for transmitting an ES (elementary stream) described in the PMT thereby to generate the PMT (program mapping table). These Office Actions also admitted that the primary reference (Blatter) also fails to disclose a recording section for retaining the specific value.

To supply this missing teaching, the Office Action applies Ohishi. Even assuming the Office Action's allegation is correct and that a specific default value is substituted for the PID values of video and audio streams to generate a new PSSI table, such a teaching would fail to remedy the noted deficiencies in Blatter, particularly as recited in the amended claims.

Indeed, Ohishi merely utilizes default values to identify specific PID packets in the PSSI. There is no disclosure or suggestion in any of the applied art even taken in combination of an information table generator that substitutes a specific value for a PID value to generate a PMT. It is wholly insufficient to point out that the specific types of tables Ohishi generates are irrelevant particularly in the face of specific tables being

referred to in the claims. For example, Applicants urge the Examiner to actually read claim 1 which requires generation of a PMT (program mapping table) and not a PSSI as alleged by the Office Action. The generation of the PMT by the claimed information table generator substitutes a specific value for the PID value of a packet for transmitting an elementary stream described in the PMT. Such a process generates a PMT, not a PSSI.

Returning to the primary reference Blatter, the Office Action alleges that Blatter's manipulation of a yet different table (the CAT (conditional association table)) somehow teaches the generation of a PMT while conveniently ignoring that these are wholly different tables. To supply this missing teaching, the Office Action turns to Ohishi which manipulates the PSSI not a CAT or a PMT. Stating that Ohishi's table types are irrelevant to the rejection ignores specific claim language, skirts the real issues, and results in an extremely weak and unsubstantiated rejection.

Nevertheless, Applicants have further amended many of the pending claims in a further effort to distinguish over the applied art. Indeed, the "first specific information table" of independent claims 1, 20, 33, and 35 have been amended to specify a PAT (program association table). Furthermore, the "second specific information tables" of these same claims have been further defined as PMTs (program mapping tables).

Returning to the Office Action, it is clear that the applied art certainly fails to disclose or suggest the invention now recited in the independent claims.

Returning to independent claims 1, 20 and 35 it is clear that Blatter fails to disclose or suggest the claimed information table generator that generates, with respect to a PAT (program association table), a new PAT containing information only on a program to be recorded in the storing unit. The Office Action alleges that Blatter's CAT table

manipulations teach this feature. Even if this allegation were once true, it is certainly no longer true because the “first specific information table” has been further defined as a PAT. Blatter simply fails to disclose or suggest any such information table generator that generates a new PAT containing information only on a program to be recorded in the storing unit as further recited in amended independent claims 1, 20 and 35.

Likewise, Blatter also fails to disclose or suggest the information table substitution unit of amended claims 1, 20, and 35 which further recites that the new PAT is substituted for an information table corresponding to the PAT contained in the packet stream transmitted. The Office Action utilizes the CAT table manipulation of Blatter to reject this feature but it is quite clear that the information table substitution unit, as amended, is distinct from these simple CAT manipulations.

Furthermore, the combination of Blatter and Ohishi fails to disclose or suggest a recording section for retaining the specific values such that subsequent reproduction of the package stream may be performed without first verifying the contents of the PMT and the PAT. The applied art, even when taken in combination, fails to disclose or suggest any such recording section that would enable subsequent reproduction of the packet stream without first verifying the contents of the PMT and the PAT. Recall also that the “specific value” is the value substituted for the PID value of a packet for transmitting an elementary stream described in the PMT and which is thereby utilized to generate the PMT by the information table generator. Ohishi’s PSSI manipulations and Blatter’s CAT table manipulations simply fail to disclose or suggest any such combination of features, particularly as recited in amended independent claims 1 and 20.

Further in regard to independent claim 35, the applied art fails to disclose or suggest a recording section for retaining the specific value such that the reproducing unit may reproduce the packet stream without first verifying the contents of the PMT or PAT.

Further in regards to independent claim 33, the combination of Blatter and Ohishi also fail to disclose or suggest the method recited therein. Specifically, neither Blatter nor Ohishi generates, with respect to a PAT (program association table) a new PAT containing information only on a program to be recorded or reproduced or substituting the new PAT for an information table corresponding to the PAT contained in the packet stream transmitted. No such generation or substitution is performed or suggested by the combination of Blatter and Ohishi.

Furthermore, Blatter and Ohishi also fail to disclose or suggest that in the generating step a specific value is substituted for the PID value of a packet for transmitting an elementary stream described in the PMT to generate the PMT or that in the substituting step the specific value is substituted for the PID value of a packet for transmitting an elementary stream contained in the packet stream transmitted as further recited in amended independent claim 33.

Still further, Blatter and Ohishi also fail to disclose or suggest the step of retaining the specific value (the one substituted for the PID value) in the substituting step of independent claim 33. Particularly, the applied art fails to disclose or suggest retaining this said specific value such that subsequent reproduction of the packet stream may be performed without first verifying the contents of the PMT and PAT. No such functionality is disclosed or suggested by the applied art.

With respect to independent claims 11 and 30, the combination of Blatter and Ohishi also fails to disclose or suggest a recording section for recording a program information index generated based on information contained in various information tables which are extracted from the packet stream. The Office Action points to the full PSI as allegedly teaching this feature but it is clear that the full PSI is a table that is received intact (see column 7, lines 58-63 stating that the received packet contains the PSI which is simply buffered in unit 60). Thus, even if the PSI is equivalent to the claimed program information index, Blatter does not generate this PSI based on information contained in various information tables which are extracted from the packet stream. Instead, Blatter merely buffers the PSI and performs no generation of a program information index as claimed.

Further in regards to independent claims 11 and 30, the combination of applied art fails to disclose or suggest substituting a specific value for PID value of a packet transmitting an elementary stream described in a program mapping table. This substitution is performed in the program information index. Similar to the arguments above, Blatter's manipulations of the CAT table and Ohishi's manipulations of the PSSI table fails to disclose or suggest these specific value substitutions for the PID value of a packet transmitting an elementary stream described in a PMT, in the program information index.

Still further, neither Blatter nor Ohishi even when taken in combination discloses or suggests a recording section for retaining the specific value such that subsequent reproduction of the packet stream may be performed without first verifying the contents of the PMT and PAT as recited in amended independent claims 11 and 30. Conventional

art like Ohishi and Blatter must still verify the PMT and PAT and only the invention permits such subsequent reproduction without first verifying the contents of PMT and PAT.

In regard to claim 42, Applicants reassert the arguments above in relation to claims 14 and 30 concerning the program information index which is a feature that is not generated based on information contained in various information tables extracted from the packet stream. Likewise, the specific value substitution is another feature in common with claims 14 and 30 which such feature is also completely absent from and not suggested by the combination of Blatter and Ohishi.

Moreover, in regard to claim 42, the applied art combination fails to disclose or suggest a recording section for retaining the specific value such that the reproducing unit may reproduce the packet stream without first verifying the contents of the PMT and PAT.

With respect to independent claim 16, Applicants have added the further distinguishing features of claim 17 thereto. Initially, it is asserted that the further distinguishing features of claim 17 lend patentability to the base features of claim 16. More specifically, neither Blatter nor Ohishi teaches or suggest the alteration of the program_number. Although Ohishi may disclose altering the PID value, Ohishi simply does not disclose or suggest altering the program_number. Even more specifically, Ohishi even when taken in combination with Blatter fails to disclose or suggest an information table generator that has a function with which the value of the program_number of a program recorded is subject to an arbitrary alteration to generate said predetermined information table. Neither does the applied art disclose or suggest an

output information insertion unit having a function with which the value obtained by the alteration of the program_number is provided to said packet stream transmitted. Without any disclosure or suggestion for altering the PID value, the applied art simply cannot disclose or suggest the claimed information table generator or output information insertion unit as now recited in amended independent claim 16.

For all the above reasons, taken alone or in combination, Applicants' respectfully request reconsideration and withdrawal of the §103 Blatter-Ohishi rejection.

35 USC 103 Blatter-Ohishi-Freimann Rejection

Claims 7, 14, 15, 19, 26, 31, 32 and 34 are rejected under 35 USC 103(a) as being unpatentable over Blatter, Ohishi and further in view of Freimann (USP 6,604,243). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

Applicants respectfully submit that Freimann does not remedy any of the noted deficiencies in the base combination of Blatter and Ohishi. Indeed, Freimann is merely applied to teach the features of certain dependent claims which are not being relied upon for patentability at this time. Therefore, the full combination of Freimann with Blatter and Ohishi fails to disclose or suggest the invention as recited in the independent claims.

Because all of the dependent claims necessarily include the features of their respective independent claims, the dependent claims should be considered allowable at least for the same reasons asserted above for the independent claims.

For all of the above reasons, taken alone or in combination, Applicants respectfully request reconsideration and withdrawal of the prior art rejections.

Conclusion


Should the Examiner believe that any outstanding matters remain in the present application, the Examiner is respectfully requested to contact Michael R. Cammarata (Reg. No. 39,491) at the telephone number of the undersigned to discuss the present application in an effort to expedite prosecution.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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